

**REMARKS**

The application was filed on 24 June 2003 with eighteen claims. The Examiner examined the application and on 18 April 2006 issued a first Action wherein claims 1-9 and 12-18 were rejected under 35 U.S.C. §101 as being directed to nonstatutory subject matter. The Examiner further rejected claims 1-4, 6-7 and 9-18 under 35 U.S.C. §102(b) by U.S. Patent 6,038,677 entitled AUTOMATIC RESOURCE GROUP FORMATION AND MAINTENANCE IN A HIGH AVAILABILITY CLUSTER CONFIGURATION to Lawlor et al. (Lawlor '677); claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Lawlor '677 in view of U.S. Patent No. 6,606,162 B1 entitled NETWORK PRINTER GROUPS to Simpson (Simpson '162); claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Lawlor '677 in view of U.S. Patent 6,826,760 B1 entitled METHODS OF FACTORING OPERATING SYSTEM FUNCTIONS, METHODS OF CONVERTING OPERATING SYSTEMS, AND RELATED APPARATUS to Hunt et al. (Hunt '760). Applicants cancelled claims 1-18 and have added new claims 19-53; in doing so, Applicants have not added new matter.

**Certified Copy of Foreign Priority Application**

The Examiner acknowledged Applicants' claim for foreign priority based on an application filed in the European Patent Office (EPO) on 19 December 2002. The Examiner, however, stated that applicant had not filed a certified copy of the 02368142.2 application. In response Applicants contend that a certified copy of the 02368142.2 application was filed when this U.S. counterpart application was filed on 24 June 2003. As evidence of the filing of the certified copy, Applicants attach a copy of a "Certificate of Mailing by Express Mail" under 37 CFR 1.10 as page 20 of this response. The Certificate of Mailing states that a certified copy was deposited with the other correspondence including the patent application, ten sheets of drawings, fee transmittal, recordation form cover sheet, signed

declaration, signed assignment, the Express Mail Certificate and a postcard. The person signing the certificate had a reasonable basis to expect that the correspondence would be mailed on the date indicated. As further evidence of the filing of the certified copy of the 02368142.2 application, Applicants also submit a copy of the postcard as page 21 of this response that was stamped by the U.S. Patent Office on 24 June 2003. Note that the postcard lists, *inter alia*, that the filing included an application, three pages of a signed declaration, an assignment with cover page, drawings, a certificate of mailing, and a **certified copy of the application**. The return postcard constitutes *prima facie* evidence that the items listed were received in the U.S. Patent Office on 24 June 2003.

### **The Rejection of claims under 35 U.S.C. §101**

The Examiner rejected claims 1-9 and 12-18 under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Examiner asserts that the language of the claims raises a question as to whether the claims are directed to an environment or machine which would result in a practical application producing a concrete, useful and tangible result. More specifically, the Examiner states that the claims just identify actions to reconfigure the data processing system and that these actions do not provide any tangible results.

Applicants have cancelled claims 1-9 and 12-18, but still respond to the Examiner's rejection. What is now claimed is a system for configuring a highly-available data processing system (independent claim 19); an apparatus to create a highly-available data processing system (independent claim 33); a method to configure a highly-available data processing system (independent claim 39); and a configurator of a highly-available data processing system (independent claim 47). Respectfully, the reconfiguration of a data processing system to be a highly-available data processing system, whether the reconfiguration be by a system or an apparatus or a method or a configurator, is definitely statutory subject matter.

In determining whether a claimed invention complies with the subject matter eligibility requirement of 35 U.S.C. §101, the Examiner is first instructed to consider that the U.S. Supreme Court determined that “anything under the sun that is made by man” is patentable so long as the claimed invention is not an abstract idea, a law of nature or a natural phenomena. See INTERIM GUIDELINES FOR EXAMINATION OF PATENT APPLICATIONS FOR PATENT SUBJECT MATTER ELIGIBILITY, U.S. Patent Office Official Gazette, 22 November 2005. The question of whether a claim encompasses statutory subject matter should focus on the essential practical utility of the subject matter.

Applicants assert the utility of configuring or creating a “highly-available data processing system” from an existing data processing system is highly practical and utilitarian. Highly-available data processing systems are fault-tolerant systems that preserve data and maintain computer processing and communication capability despite failure of one or more components or resources. See Specification at page 1, lines 11-16. Therefore, what is created by the system, the apparatus, the method, and the configurator is a highly-available data processing system from a pre-existing system that was not fault-tolerant. In the industry of computerized data processing, it is difficult to imagine what could more useful than a fault-tolerant system of critical processing machines and applications. Respectfully, Applicants request the Examiner to withhold a rejection of the newly added claims under 35 U.S.C. §101.

**The Rejection of claims over Lawlor ‘677**

The Examiner rejected claims 1-4, 6-7 and 9-18 under 35 U.S.C. §102(b) as being unpatentable over Lawlor ‘677. These claims have been cancelled without disclaimer or prejudice. Applicants, however, maintain that the invention as claimed in claims 19-53 are not anticipated over Lawlor ‘677.

Lawlor '677 teaches a method and a computer program product that automatically generates and maintains resource groups for a clustered computer-network configuration. An administrator identifies a set of resources that must be collocated with a given application. Then two constraints are automatically applied to these resources to generate a resource group that is fault-tolerant.

Applicants contend that Lawlor '677 is not applicable to any of independent claims that are newly-added because Lawlor '677 does not teach or suggest the "inspection agent" that automatically explores and inspects a production server, or the expert-system module of claim 19, or the interrogation agent, the knowledge expert agent, and the automatic analysis engine of claim 33. Lawlor '677, moreover, does not teach or hint at automatically inspecting a computer system, does not invoke an expert-system client-side software agent to automatically analyze the computer system using an expert knowledge database, as in claim 39. With respect to claim 47, Lawlor '677 does not disclose or even hint at using a knowledge database to configure a highly-available data processing system.

Lawlor '677 simply discloses a menu wherein a user identifies the applications, Internet Protocol (IP) addresses, and the disk partitions to be collocated into a resource group. *See* Lawlor '677 at column 4, lines 45-50. Note, that inspection of a production computer is not automatic; note that the identification of computer parameters that are necessary to a critical application is not an automatic process, it is accomplished by a user/administrator; note that an expert-system using a knowledge database is not applied to the identified computer parameters. Only two rules are applied: first, that the collocated resources have the same resource group and second, that partitions within the same disk have the same resource group. Lawlor '677 at column 5, lines 1-8. Specifically, Lawlor '677 also teaches away from Applicants' claimed invention because Lawlor '677 specifically states that the "resources in a resource group need to 'stay together' or be 'collected' on the same computer at all times" because

of the constraint that the resources have the same IP address. Lawlor '677 at column 1, lines 37-39. Lawlor '677 also states that humans, not a expert system knowledge database, specify the collocation requirements, *see* Lawlor '677 at column 7, lines 33-35. No doubt, Lawlor '677 intends to protect a critical application on a single computer by eliciting selection of critical resources from a user/administrator. Applicants' invention is much more and is claimed as such.

**The Rejection of claim 5 over Lawlor '677 in view of Simpson '162**

The Examiner applies Simpson '162 to Lawlor '677 to reject old claim 5. These claims have been cancelled without prejudice or disclaimer, therefore the rejection of these claims is no longer pertinent.

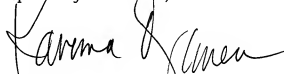
**The Rejection of claim 8 over Lawlor '677 in view of Hunt '760**

The Examiner applies Hunt '760 to Lawlor '677 to reject old claim 8. Claim 8 is cancelled without prejudice or disclaimer, therefore the rejection is no longer pertinent. Applicants point out, however, that Lawlor '677 and Hunt '760 teach against their alleged combination. Recall that Lawlor '677 specifically states that the resource group must have the same IP address, i.e., must be on the same computer. Hunt '760, on the other hand, teaches that operating system functions, specifically programming objects in an object-oriented computer environment, can be distributed across machine boundaries, and that applications can call methods to call these distributed operating system functions. *See* Hunt '760, Abstract. Thus, these two references, Lawlor '677 and Hunt '760, cannot be combined without destroying the function of Lawlor '677. Applicants have thus overcome any *prima facie* case of obviousness based on the combination of Lawlor '677 and Hunt '760.

**Conclusion**

Attorney for Applicants thank the Examiner for his review of the application. Applicants cancelled the original claims 1-18 and have submitted new claims 19-53 that distinctly point out and specifically claim an automatic inspection agent and a method that automatically inspects and collects computer parameters necessary to a critical data processing operation, and further claim an automatic expert engine and its method that applies a knowledge database to the collected computer parameters. Based on the results of the method used by the automatic expert engine, the computer parameters can be collocated automatically and mirrored to a different processing system. Attorney for Applicants requests the Examiner to examine the new claims and allow the application. The Examiner is further invited to telephone the Attorney listed below if he thinks it would expedite the prosecution and the issuance of the patent.

Respectfully submitted,

  
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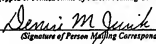
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PATENT TRADEMARK OFFICE

<b>CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)</b> Applicant(s): <b>A. Fabrizio et al.</b>			Docket No. <b>FR920020082US1</b>	
Serial No.	Filing Date Herewith	Examiner	Group Art Unit	
Invention: <b>METHOD FOR CONFIGURING A DATA PROCESSING SYSTEM FOR FAULT TOLERANCE</b>				
<p>I hereby certify that the following correspondence:</p> <div style="border: 1px solid black; padding: 5px; margin: 10px 0;">           Patent Application, 10 sheets drawings, Fee Transmittal, Recordation form cover sheet, Declaration (signed), Assignment (signed), Certified copy, Express Mail Certificate, Postcard         </div> <p style="text-align: center; font-size: small;"><i>(Identify type of correspondence)</i></p> <p>is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on</p> <p style="text-align: center;"><u>6/24/03</u></p> <p style="text-align: center; font-size: x-small;"><i>(Date)</i></p> <div style="text-align: right; margin-top: 20px;"> <u>Denise M. Jurik</u>  <small><i>(Typed or Printed Name of Person Mailing Correspondence)</i></small>    <small><i>(Signature of Person Mailing Correspondence)</i></small>  <u>EV 342658750 US</u>  <small><i>("Express Mail" Mailing Label Number)</i></small> </div>				

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 Docket No. FR920020082US1  
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